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| 10/777,239 | 02/12/2004 | James M. LeClair JR. | 01-CLP-444 CIP#1 | 4498 |
| 200 | 7590 | 01/06/2006 | EXAMINER | |
| EATON CORPORATION EATON CENTER 1111 SUPERIOR AVENUE CLEVELAND, OH 44114 | | | MITCHELL, KATHERINE W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3677 | |

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

Response to Amendment

1. The amendment to the claims filed on 11/21/2005 does not comply with the requirements of 37 CFR 1.121(c) because the claims must begin on a separate page and **be properly identified with one of the 7 approved claim status identifiers.**

Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). **The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.**

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

2. However, applicant's response can be understood by examiner, and rather than subject applicant to additional delays and fees, examiner is examining the claims as presented and assuming claims 2-8 are --(original)-- after comparison to claims filed 2/12/2004. However, applicant should note the new rule changes above.

Specification

3. The abstract of the disclosure is objected to because line 10 includes "means". Correction is required. See MPEP § 608.01(b). Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology**

often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

Drawings

4. Examiner notes applicant's statement that Figure 1 is not prior art, but illustrates the claimed invention and is canceling the objection. However, so the record is clear, applicant should have at least some description in the specification of what in Fig 1 is the claimed invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 7-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Niemiec, USP 5199718. Examiner notes that the portion of claim 1 prior to "characterized by said seal assembly comprising" is applicant's admitted prior art per applicant's "Background of the Invention" and Fig 1.

Niemiec teaches a rotary fluid pressure device (Fig 2) having a seal assembly comprising, in the order of direction of leakage flow from the pressurized case drain region:

- A high pressure shaft seal (54 or 52, see col 3 lines 11-33, noting that either can be high or low pressure (sub- or supra-atmospheric pressure))

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- An annular chamber in which is disposed a rigid backup member (58) adjacent the high pressure (HP) shaft seal, said backup member cooperating with one of the housing means (12), high pressure shaft seal and input-output shaft (14) to define a fluid passage means (48)
- A drain passage disposed between said annular chamber and a case drain port, whereby fluid leaking from said case drain region past said HP shaft seal flows through said fluid passage means, then through the drain passage (46) to said case drain port (68- external to housing)
- And a low pressure (LP) shaft seal (54 or 52, see col 3 lines 11-33, noting that either can be high or low pressure (sub- or supra-atmospheric pressure))

Re claims 7-8: the backup member can be considered to cooperate with the input output shaft (14) to define axially extending fluid passage means per Fig 2. The passage is 3-dimensional and thus the fluid passage means can be considered to be both axially and radially extending.

Note that applicant did not claim "directly cooperate", and two things can be considered to cooperate with each other by way of their common cooperation to something else.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zumbush USP 4491332 in view of Niemiec USP 5199718. Examiner notes that the portion of claim 1 prior to "characterized by said seal assembly comprising" is applicant's admitted prior art per applicant's "Background of the Invention" and Fig 1.

Zumbush teaches a rotary fluid pressure device (Fig 2) characterized by said seal assembly comprising a HP shaft seal (Fig 4), an annular chamber in which is disposed a rigid backup member (85) and a LP seal (53). The fluid pressure operated displacement means may comprise an internally toothed ring member (23) and an externally toothed star member (27) which comprises the movable member (Fig 1). Star member (27) may be disposed eccentrically within said ring member (23) for relative orbital and rotational movement. Valve member may comprise a hollow generally cylindrical spool valve member (41). The fluid pressure in the inlet port (near rearward end) surrounds the spool valve member over a limited axial extent thereof.

However, Zumbusch fails to disclose a backup member cooperating with one of the housing means, high pressure shaft seal, and input-output shaft to define a fluid passage means. Niemiec teaches such an arrangement in col 3 lines 47-51, as also shown in Fig 2 -- an annular chamber in which is disposed a rigid backup member (58) adjacent the high pressure (HP) shaft seal (54), said backup member cooperating with one of the housing means (12), high pressure shaft seal (54) and input-output shaft (14) to define a fluid passage means (48). The backup member can be considered to cooperate with the input output shaft (14) to define axially extending fluid passage

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means per Fig 2. The passage is 3-dimensional and thus the fluid passage means can be considered to be both axially and radially extending.

Note that applicant did not claim “directly cooperate”, and two things can be considered to cooperate with each other by way of their common cooperation to something else.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Zumbusch as taught by Niemiec to include a backup member cooperating with one of the housing means, high pressure shaft seal, and input-output shaft to define a fluid passage means in order to allow fluid to flow externally of the housing, to ensure that the fluid does not build up pressure and/or overheat in the seal.

Additionally regarding claim 4: In an apparatus claim, if the structure claimed is present, it is assumed that the method of use limitations are met.

Allowable Subject Matter

9. Claims 2-3 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and intervening claims.

Response to Arguments

10. Applicant's arguments filed 11/21/2005 have been fully considered but they are not persuasive.

Applicant argues that Niemiec fails to teach a high pressure seal. Note that col 3

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lines 20-33 are clear that the seals 52 and 54 can be used as sub- or supra-atmospheric seals. Absents any further limitation or definition, this is considered to meet the claim limitations as written. Further, "high-pressure" is a relative term and that is part of the intended use of the structure. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues that Zumbush is an exclusion seal for dust, water, etc. and thus is not used as applicant's low pressure seal is used. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., capable of withstanding pressurized fluid greater than atmospheric pressure so that this exclusion seal could prevent the egress of fluid from the motor to the environment; extending seal life) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The only seal structure claimed is a high pressure shaft seal and a low pressure shaft seal, and they are clearly at least capable of serving as high and low pressure seals, since the exclusion seal is by its nature a low pressure seal of some sort - dust is not pressurized, and the other seal seals against pressurized fluid, and is thus considered a high-pressure (relative to exclusion seal) seal.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

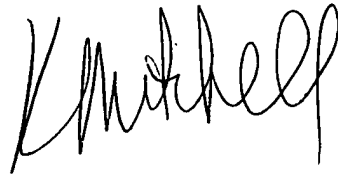
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Katherine W Mitchell
Primary Examiner
Art Unit 3677

A handwritten signature in black ink, appearing to read 'K Mitchell', written in a cursive style.

Kwm
1/3/2006